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SHELTON, CT 06484-6212

EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2611

*14*

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/735,946

Applicant(s)

DARBY ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### Response to Arguments

1. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims to address combining a first and second video feed, stating that the second video feed is the Internet address. This limitation is not supported by the specification. In the specification on Page 4, Lines 6-7 the applicant discloses "a computer monitor receiving a video feed", and on Page 8, Lines 5-6 the applicant discloses "a computer having a monitor that displays a video feed, a monitor that displays a video feed". Furthermore on Page 7, Lines 13-15 of the specification, the applicant discloses "an ability to perform "media casting", wherein by example the stripe has its own feed (separate from the program/advertising feed), and where multiple information and viewing appliances may be responsive to receiving the

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stripe transmission". Figure 1 clearly suggests that TV Studio 14 is providing a video feed, but as for "Other Info" 20a and Server 16, there is no suggest of either of these two signals being sent to the combiner 20 being a video feed in any of the figures or in the specification.

Therefore, for the remainder of this Office Action, the examiner will assume that the limitation "second video feed" in regards to the address or URL information coming from "Other Info" 20a or Server 16 is simply a "second feed".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22, 24, 26-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071).

Referring to claim 1, Bendinelli discloses a first video feed comprising a program/advertising video feed and the second feed comprising information for specifying an address of a location in a global data communication system where a party associated with the program/advertising video feed can be contacted, and further comprising additional information related to the program/advertising video feed (see Figures 1-2 for receiving a television signal where a URL has been embedded in the TV

signal and Column 3, Lines 16-24 for the URL relating to the television program being transmitted).

Bendinelli also discloses transmitting a television signal obtained from the output of said combiner (see Column 3, Lines 16-19 and Figure 1).

Bendinelli also discloses that a first area of a television monitor screen (Display 38 in Figure 3) displays programs (see Column 5, Lines 33-35) and advertisements (note that a television program contains commercial breaks (see Column 3, Lines 21-24), therefore, the television signal contains both the television program ("Friends" for example) and commercial breaks ("an advertisement to buy toothpaste")), and a second area of the television monitor screen displays (see PIP window for displaying other information (see Column 5, Lines 37-40)), during a time that the first area of the television monitor screen is displaying an advertisement for an advertiser, displaying information in said second area for specifying an address of a location in a global data communication system where the advertiser can be contacted, in addition to the additional information (see Column 3, Lines 21-24 for displaying an advertisement in a second area, and Column 3, Lines 47-50 for displaying the actual web address in the second area, where the web address corresponds to additional information (when the web page has been accessed)).

Bendinelli discloses embedding the URL into the video signal (combining), but fails to specifically disclose a combiner or two separate feeds (a video feed that supplies the television signal and a separate feed that supplies the URL). Hiroi discloses two

separate feeds for supplying a video signal and URL (see elements 120 and 140 in Figure 1) and a combiner for combining the two signals (see element 150 in Figure 1).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the broadcast transmitter 32, as taught by Bendinelli, using the two separate feeds (elements 120 and 140) and the combiner 150, as taught by Hiroi, for the purpose of providing additional ancillary services to the basic DTVB service at any time (see Column 4, Lines 56-57 of Hiroi).

Referring to claim 2, see the rejection of claim 1, and that Bendinelli additionally teaches at Column 3, Lines 21-24 displaying an advertisement in a second area, and Column 3, Lines 47-50 for displaying the actual web address (URL) in the second area.

Claim 3 corresponds to claim 2, where Bendinelli teaches a PIP window 44 in Figure 3, which is a stripe across the bottom of the display 38.

Claim 4 corresponds to claim 3, where Bendinelli discloses at Figure 3 for the PIP window 44 being smaller than the display window 38, which is about 12% of the total display.

Claim 5 corresponds to claim 2, where Bendinelli teaches the additional limitation in the rejection of claim 2, and note that displaying the actual URL is displaying text to the display window 38 (for example, displaying <http://www.google.com>).

Claim 6 corresponds to claim 2, where Bendinelli discloses that the program can be an advertisement (see Column 3, Lines 21-24) or an actual program (see viewing music videos at Column 3, Lines 27-29), therefore there is a time where a first area is displaying program and another time where advertisements are displayed. Also note

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that at Column 4, Lines 3-8 and 34-37 Bendinelli discloses that the data in the second area is only changed when a new URL is sent to the set-top box, therefore if a program goes to commercial, if there is no URL in the closed caption stream, then there will inherently be no change in the second area even after the commercial has finished airing.

Claims 7-12 correspond to claim 2, where Bendinelli discloses displaying a web page according to the URL embedded in the television signal at Column 3, Lines 57-63 and the actual URL at Column 3, Lines 21-24. The examiner notes that the additional claims 8-12, which teach different types of information being displayed in the second window, can be provided by either displaying the actual URL to the user or the web page to which the URL addresses, therefore rendering these claim limitations to non-functional descriptive claim language (see MPEP section 2106 IV (pages 2100-21 and 2100-22)). A URL is inherently a link to any type of product or service on the Internet.

Referring to claim 13, see rejection of claims 2 and 3.

Referring to claims 14-21, see rejection of claims 4-5 and 7-12, respectively.

Claim 22 corresponds to claim 13, where Bendinelli discloses the additional limitation in the rejection of claim 6 and note that if the web page being displayed in PIP window 44 is controlled by when the URL is transmitted to the set-top box, then the system inherently can change the display in PIP window 44, before, during or after the commercial advertisement is transmitted.

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Claim 24 corresponds to claim 13, where Bendinelli discloses that the further information is related to the commercial appearing in the second area (see Column 3, Lines 21-24).

Referring to claim 26, see rejection of claim 1, and also note that Bendinelli discloses a combiner for combining a television signal (which includes ad signals (commercials)) and an information signal (URL) into a unified signal at Column 5, Lines 9-13).

Referring to claims 27-32, see rejection of claims 2-7, respectively.

Referring to claims 33-34, see the rejection of claims 32, and note that a URL is a promotional message from the advertiser and that multiple products are advertised over the Internet for display by a website, which can be accessed by the URL.

Referring to claim 35, see rejection of claim 22.

Referring to claim 37, see rejection of claim 26.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071) in further view of Portuesi (U.S. Patent No. 5,774,666).



Referring to claim 23, Bendinelli and Hiroi disclose all of the limitations in claim 13, as well as displaying further information in the stripe, where the information comprises an identification of the advertiser (see Column 3, Lines 21-24). Bendinelli fails to disclose that the identification being displayed extends beyond a top border of the stripe into the first area. Portuesi teaches in Figure 3, displaying a URL 32 in the first area, while a caption identifying the advertiser is displayed in caption stripe 34, where the URL 32 is above the top border of the stripe 34 (see also Column 5, Lines 59-67 and Column 6, Lines 1-19).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the PIP (stripe) display of Bendinelli and Hiroi, using the additional information (element 32 in Figure 3), as taught by Portuesi, for the purpose of providing hot spots on the display for users to access (see Column 3, Lines 16-18 of Portuesi).

Referring to claim 36, see rejection of claim 23.

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5. Claims 25 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071) in further view of Alexander et al. (U.S. Patent No. 6,177,931).

Referring to claim 25, Bendinelli and Hiroi disclose all the limitations in claim 26, as well as displaying further information in the stripe, but fails to teach that the information in the stripe being a function of a type of viewing audience of a program with which the commercial appears. Alexander teaches developing a user profile, which can

be used to define the display of additional information in a second region of the screen (see Column 30, Lines 45-58 for determining which information goes into the PIP advertisement window).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the display of Bendinelli and Hiroi, using the viewer profile used for customizing a display for an audience (the user), as taught by Alexander, for the purpose of providing the user with improved viewer interaction capabilities with the display (see Column 2, Line 5 of Alexander).

Referring to claim 39, see rejection of claim 25.

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6. Claims 39-42, 45-46, 48-56 and 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071) in further view of Portuesi (U.S. Patent No. 5,774,666).

Referring to claim 39, Bendinelli discloses a first video feed comprising a program/advertising video feed and the second feed comprising information for specifying an address of a location in a global data communication system where a party associated with the program/advertising video feed can be contacted, and further comprising additional information related to the program/advertising video feed (see Figures 1-2 for receiving a television signal where a URL has been embedded in the TV signal and Column 3, Lines 16-24 for the URL relating to the television program being transmitted).

Bendinelli also discloses transmitting a television signal obtained from the output of said combiner (see Column 3, Lines 16-19 and Figure 1).

Bendinelli also discloses that a first area of a television monitor screen (Display 38 in Figure 3) displays programs (see Column 5, Lines 33-35) and advertisements (note that a television program contains commercial breaks (see Column 3, Lines 21-24), therefore, the television signal contains both the television program ("Friends" for example) and commercial breaks ("an advertisement to buy toothpaste")), and a second area of the television monitor screen displays (see PIP window for displaying other information (see Column 5, Lines 37-40)), during a time that the first area of the television monitor screen is displaying an advertisement for an advertiser, displaying information in said second area for specifying an address of a location in a global data communication system where the advertiser can be contacted, in addition to the additional information (see Column 3, Lines 21-24 for displaying an advertisement in a second area, and Column 3, Lines 47-50 for displaying the actual web address in the second area, where the web address corresponds to additional information (when the web page has been accessed)).

Bendinelli discloses embedding the URL into the video signal (combining), but fails to specifically disclose a combiner or two separate feeds (a video feed that supplies the television signal and a separate feed that supplies the URL). Hiroi discloses two separate feeds for supplying a video signal and URL (see elements 120 and 140 in Figure 1) and a combiner for combining the two signals (see element 150 in Figure 1).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the broadcast transmitter 32, as taught by Bendinelli, using the two separate feeds (elements 120 and 140) and the combiner 150, as taught by Hiroi, for the purpose of providing additional ancillary services to the basic DTVB service at any time (see Column 4, Lines 56-57 of Hiroi).

Ø Bendinelli and Hiroi fail to disclose that the first video feed is pre-recorded video feed. Portuesi discloses that television signals can be a pre-recorded video feed from a VCR (see Column 9, Lines 12-21).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the broadcast transmitter and video stream generator, as taught by Bendinelli and Hiroi, using the VCR, as taught by Portuesi, for the purpose of supplying previously aired programming or a movie that the user has previously passed on viewing.

Claim 40 corresponds to claim 39, where Hiroi teaches that the second feed is supplied by the advertiser (see broadcast data generator 140 in Figure 1 for transmitting URLs, which are advertisements, therefore the second feed inherently transmits advertisements (URLs) and is therefore an advertiser).

Claim 41 corresponds to claim 39, where Hiroi discloses that the broadcast generator 140 sends advertisements (URLs) to the combiner 150 during a time when the first video feed 120 is sending video to the combiner (see Figure 1 and Column 4, Lines 47-67).

Claim 42 corresponds to claim 39, where Bendinelli discloses transmitting URL data, which is the text representation of the location of a web site (for example, [www.google.com](http://www.google.com)).

Claim 45 corresponds to claim 39, where Bendinelli discloses transmitting URL data (see Column 1, Lines 61-67).

Claim 46 corresponds to claim 39, see the rejection of claim 45, where a URL is promotional material.

Claim 48 corresponds to claim 39, where Portuesi discloses at Column 5, Lines 59-67 and Column 6, Lines 1-19 that the URLs are displayed at specific time intervals, therefore the URL can inherently be supplied before or after the television signal is transmitted.

Claim 49 corresponds to claim 39, where Bendinelli discloses receiving and recording data related to feedback from the viewers (see Column 5, Lines 47-54 for storing a list of web pages that the user may receiving by accessing the stored (recorded) list).

Claims 50-51 corresponds to claim 39, where Bendinelli discloses displaying a web page according to the URL embedded in the television signal at Column 3, Lines 57-63 and the actual URL at Column 3, Lines 21-24. The examiner notes that the different types of information being displayed in the second window, can be provided by either displaying the actual URL to the user or the web page to which the URL addresses, therefore rendering these claim limitations to non-functional descriptive

claim language (see MPEP section 2106 IV (pages 2100-21 and 2100-22)). A URL is inherently a link to any type of product or service on the Internet.

Claim 52 corresponds to claim 39, where Bendinelli discloses that the information is related to the program being aired (see Column 3, Lines 16-24), but fails to disclose that the advertisement is selected to be of interest to an expected viewing audience of the program. The examiner takes Official Notice that it is well known to insert advertisements and URLs into a video stream in order to appeal to a particular viewing audience of interest. At the time the invention was made, it would have been obvious to modify the television signal URL insertion system, as taught by Bendinelli, Hiroi and Portuesi, using the targeted advertising method, for the purpose of providing a specific advertisement to a viewer, which would have the maximum impact and interest peaking power.

Claim 53 directly relates to claim 39, with the additional limitation of the second area being rectangular in shape and extending from one edge of the television monitor screen to an opposite edge. Portuesi clearly discloses in Figure 3 a caption 34, which is described at Column 6, Lines 12-14 as containing a URL (which is transmitted from a server in the video signal). Therefore, Bendinelli, Hiroi and Portuesi teach all of the limitations of claim 53.

Referring to claims 54-56, see the rejection of claims 40, 42 and 46, respectively.

Referring to claims 58-61, see the rejection of claims 59-52, respectively.

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7. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071) in further view of Portuesi (U.S. Patent No. 5,774,666) in further view of Wu et al. (U.S. Patent No. 6,326,982).

Referring to claims 43-44, Bendinelli, Hiroi and Portuesi disclose all of the limitations in claim 39, but fail to disclose that the information is video or animation. Wu discloses a WEB/TV system that contains URL display layout parameters, which are used to display video animation graphics (see Column 7, Lines 53-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the system of Bendinelli, Hiroi and Portuesi, to include video animation graphics information, as taught by Wu, for the purpose of providing more detailed URL link information that further entices the viewer to select the advertisement.

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8. Claims 47 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Hiroi (U.S. Patent No. 6,256,071) in further view of Portuesi (U.S. Patent No. 5,774,666) in further view of Zenith et al. (U.S. Patent No. 6,519,771).

Referring to claim 47, Bendinelli, Hiroi and Portuesi disclose all of the limitations in claim 39, but fail to disclose that the information comprises live Internet chat. Zenith discloses a WEB/TV system, where the user can enter a chat room related to the program being displayed (see Column 5, Lines 21-25).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the WEB/TV system of Bendinelli, Hiroi and Portuesi, using the TV chat 122 option, as taught by Zenith, for the purpose of facilitating communication between strangers as well as friends and family (see Column 1, Lines 11-15 of Zenith).

### ***Conclusion***

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 16, 2004

  
VIVEK SRIVASTAVA  
PRIMARY EXAMINER